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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/667,754

09/22/2003

Kuniya Sonehara

032405.155

1375

25461 7590 03/31/2008

SMITH, GAMBRELL & RUSSELL  
SUITE 3100, PROMENADE II  
1230 PEACHTREE STREET, N.E.  
ATLANTA, GA 30309-3592

EXAMINER

MARKOFF, ALEXANDER

ART UNIT

PAPER NUMBER

1792

MAIL DATE

DELIVERY MODE

03/31/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/667,754	<b>Applicant(s)</b> SONEHARA, KUNIYA	
	<b>Examiner</b> Alexander Markoff	<b>Art Unit</b> 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7 and 9-44 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 9-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 28-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/22/08 has been entered.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 29, 30, 34-38 and 40-44 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 07-148451.

JP 07-148451 teaches a method which comprises the claimed steps. See entire document, especially Drawing 1 and the related description.

The method utilizes an apparatus comprising: first separation tank (8), flotation and dispersing agents adding means (11 and 12), first taking out means (13), circulating means (20), second separation tank (9), second taking out means (19, 18), foreign matter separating tank (26), stirring means (38) in the tank (26), foreign matter

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separating means ((26F), third taking out means (32, 31), and centrifugation paint separation means (27). JP 07-148451 also teaches a method which comprises the claimed steps. See entire document, especially Drawing 1 and the related description.

AS to the newly added limitation reciting that the dispersing agent serves to finely divide paint particles and render them non-sticky: Since the result of application of the agents in the applied document provide the same resulting floating paint particles the action of the applied agents is inherently the same.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 28 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 07-148451.

JP 07-148451 does not specifically state that the used alkali chemicals are hydroxides. However, hydroxides of sodium and potassium are the most common alkali chemicals used in the industry. It would have been obvious to an ordinary artisan at the time the invention was made to use the known and commercially available compounds for their known property. Thereby, it would have been obvious to an ordinary artisan at the time the invention was made to use hydroxides of sodium or potassium in the method of JP 07-148451 with reasonable expectation of success.

AS to claim: 39:

JP 07-148451 does not specify the size of fluctuates. However, it is reasonably believed that since the manipulative steps of the method of the JP document comprises the same manipulative steps at least some of the resulting flocculates would have the claimed size.

7. Claims 1-4 and 28-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 07-148451 in view of Forney (US 3861887), Gabel et al (US 4,055,495), Mauceri (US 4,067,806) and Cody et al (US Patent No 5,034,136).

For claims 1-4, 29, 30, 34-38 and 40-44 this is an alternative rejection.

JP 07-148451 was discussed above.

JP 07-148451 does not specifically state that the dispersing agent serves to finely divide paint particles and render them non-sticky.

Forney, Gabel et al, Mauceri and Cody et al teach that it was known to add hydroxides, salts producing hydroxides, including aluminum hydroxide, and modified clays in the paint reclaiming processes to improve paint separation. The documents teach that such salts, hydroxides and clays were used in addition or as alternative to the conventional methods utilizing alkali chimerical.

It would have been obvious to an ordinary artisan at the time the invention was made to use the chemicals disclosed by Forney, Gabel et al, Mauceri and Cody et al in the method of JP 07-148451 with reasonable expectation of success in order to improve the process of paint separation.

### ***Response to Arguments***

8. Applicant's arguments filed 01/22/08 have been fully considered but they are not persuasive.

The applicants allege that the agents disclosed by the JP document do not provide the results required by claim 1. The examiner disagrees. The document teaches producing the flocks and uses the same agent as claimed – polymers.

It is further noted that the most common alkali chemicals are hydroxides.

The claims recite polymers and hydroxides.

The JP document teaches polymers and alkali (hydroxides).

Thereby, the rejection is proper or the claims and/or disclosure lack essential subject matter and not in correspondence with the requirements of 35 USC 112(1).

The new rejection incorporating the teachings of Forney, Gabel et al, Mauceri and Cody et al is added.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Markoff whose telephone number is 571-272-1304. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on 571-272-1414. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Alexander Markoff  
Primary Examiner  
Art Unit 1792

/Alexander Markoff/  
Primary Examiner, Art Unit 1792